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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/066,005	01/31/2002	Neil D. Scancarella	Rev 01-3	5183
26807 7590 06/01/2009 JULIE BLACKBURN REVLON CONSUMER PRODUCTS CORPORATION 237 PARK AVENUE NEW YORK, NY 10017				
EXAMINER				
YU, GINA C				
ART UNIT		PAPER NUMBER		
1611				
MAIL DATE		DELIVERY MODE		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary**Application No.**

10/066,005

Applicant(s)

SCANCARELLA ET AL.

Examiner

GINA C. YU

Art Unit

1611

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 March 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17 and 38-41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17, 38-41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on March 24, 2009 has been entered.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 17 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.

The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 17 now requires "a dimethicone of 500,000 to 640,000 cSt". Applicant indicates in remarks the support is found in pages 10-12 and page 30, Example 3. However, on page 10, lines 10-11 the disclosed viscosity range of dimethicones is from 500,000 to 10 million without any unit. Example 3 on page 30 indicates the viscosity of

the dimethicone employed in the formulation in centistokes, "0.65 cs". The original disclosure lacks support for the range "500,000 to 650,000 cSt".

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 17, 38-41 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 17 is rendered vague and indefinite because it is not clear whether the claimed invention is a single composition or a set of two separate compositions. The claim recites "[a] lip cosmetic comprising an anhydrous pigmented transfer resistant, film forming, cross-linked resinous silicone, composition having a dimethicone of 500,000 to 650,000 cSt, in combination with a non reactive wetting agent having affinity to the composition . . . ". Since the lip cosmetic is said to comprise the "composition" in combination with the wetting agent, it is not clear whether the claim is directed to a lip product containing the composition and the wetting agent as a single product.

Claims 39 and 40 require the "wetting agent" be semi-solid and solid, respectively, at 25 C. Such limitations render the claims vague and indefinite because claim 17, the base claim, already defines the wetting agent as a liquid polymeric hydrocarbon. See claim 17, line 4, "said wetting agent being an alpha olefin copolymer, which copolymer is a liquid polymeric hydrocarbon . . . ". (emphasis inserted). The base claims has defined the wetting agent as the liquid hydrocarbon copolymer,

however, it appears the "wetting agent" in these claims no longer is required to be the liquid polymeric hydrocarbon, rendering the claims vague and confusing.

The remaining claims are rejected as they depend on the indefinite base claim.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 17, 38-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Drechsler et al. (US 6074654) in view of Manufacturing Chemists ("New uses for old colour materials", June 1, 1999), ExxonMobile Chemical Technical Data, and Collin (US 6641821 B1).

Drechsler discloses a lip color film-forming composition comprising crosslinked organosiloxane resins such as Wacker 803 from Wacker Silicones Corp. (trimethylsiloxysilicate) and pigments in a volatile carrier. See col. 7, line 46 - col. 9, line 2. The reference also discloses a method of enhancing the gloss, shine, and feel of lip composition by apply a complimentary product, known as "overcoat" or "topcoat", over the film formed after application of a transfer-resistant lip composition. See col. 10, line 63 - col. 16, line 7. The reference teaches that the overcoating composition can be liquid or solid and include "any that are commercially available or to be developed, provided the aggregate of the materials comprising the overcoat does not significantly disrupt" the film-forming composition. See col. 11, line 64 - col. 12, line 29. There is no teaching in Drechsler to us non-volatile silicone oil in the coating composition. The reference also teaches in col. 2, lines 7-13 that it is well known in the art to formulate a

transfer-resistant cosmetic composition with trimethylated silica and volatile solvent.

The reference teaches using the film forming silicone resin in the amount ranging from 10 to 95 %.

Drechsler does not specifically teach the wetting agent of the present claims.

Manufacturing Chemists teaches polyalpha olefins (notably polydecene) are popular oil-free emollients and "pigment wetting and dispersing aids", known for a recommended replacement for mineral oil. These emollients are "colourless, odourless, non-toxic and non-greasy and blend well with most cosmetic oils". The reference teaches the products under PureSyn trademark from Mobil Chemicals and Arlamol brand by Uniquema are available in different viscosity grades.

According to Exxon Mobile Chemical, PureSyn polyalphaolefins are hydrogenated hydrocarbon fluid. The reference teaches PureSyn 150 and 300 having number average molecular weights of 3,500 and 5,100, respectively.

Collin teaches polyalpha olefin wax has been used in film-forming, transfer-free make up compositions. The reference teaches the film-forming compositions contain polyalpha olefin wax, at least one volatile hydrocarbon oil, a film-forming polymer, and liquid fatty phase. See col. 2, lines 16 - col. 3, line 34. The reference teaches the film obtained from the composition is stable and exhibits a good hold; resistant to water, to rubbing, to perspiration. See col. 1, lines 50 – 62. The application of the transfer-resistant composition comprising polyolefin wax encompasses lip products. See col. 2, lines 4 – 8.

It would have been obvious to one of ordinary skill in the art at the time of the present invention to modify the teachings of Drechsler by substituting the overcoat product with polyalpha olefins as motivated by Manufacturing Chemist because the latter teaches polyalpha olefins are popular oil-free emollients and pigment wetting agent which are also colorless, odorless, non-toxic and non-greasy, and blends well with most cosmetic oils. The skilled artisan would have had a reasonable expectation of successfully producing an overcoat product for the transfer-free lip composition because Drechsler teaches the overcoating composition can be liquid or solid and should not significantly disrupt" the film-forming composition, and Collin teaches poly alpha olefins are already known to be comparable with film-forming transfer-free. The presently recited interaction "with the internal and external surfaces and matrices of the composition by seeping into spaces and surfaces sufficient to wet the composition" is viewed as the resulting wetting property of the polyalpha olefins as suggested by Manufacturing Chemists.

Oath/Declaration

The declaration presents a comparison test between the film-forming lip color compositions of the Drechsler reference and of the present invention. Both compositions comprise "isododecane, trimethylsiloxysilicate, quaternium-18 hectorite, propylene carbonate, and color". For the prior art composition, dimethicone having viscosity of "> 1M cSt" was employed, and for applicant's lip color, dimethicone of 600,000 cSt. These lip color film-forming compositions were tested for affinity with the non-reactive wetting agent as defined in claim 17. The application of the wetting agent

onto the films obtained from the lip color of the present invention is said to produce an interaction with the internal and external surfaces and matrices of the film seeping into spaces and surfaces sufficient to wet the composition; the prior art lip color comprising a dimethicone of " $\geq 1\text{ M cSt}$ " causes no such interaction.

Examiner views the declaration is insufficient to overcome the obviousness rejection in this case because the comparison test does not disclose all the necessary data to conclude that the present invention has unexpected results over the prior arts.

In the comparison test, no weight amounts of the ingredients in the lip color formulations are known. Thus it is not clear whether the viscosities of the dimethicones are the only variables in the comparison test and whether the viscosity of a dimethicone in the coloring film-forming composition is indeed the critical factor which would rendered the alleged unexpected wetting interaction between the film-forming composition and the wetting agent.

Also unclear is whether the same wetting agent was applied to the lip color film-forming compositions. The declaration merely indicates a non reactive wetting agent having the description of instant claim 17, but does not disclose what particular component was used in the experimentations.

Also, the dimethicone having greater than 1 M cSt does not necessarily represent the dimethicone of the closest prior art because greater than 1M cSt is open to any value higher than 1M. It is also noted that in the formulation table the viscosity of the prior art is designated as greater than 1 M cSt, while the conclusion discusses a

prior art dimethicone of viscosity greater than or equal to 1M cSt, causing inconsistency of the data. Furthermore, as indicated in the new matter rejection above under 35 U.S.C. § 112, first paragraph, there is no support in the original disclosure that the present invention requires a dimethicone of less than or equal to 600,000 cSt.

For above reasons, the declaration does not overcome the obviousness rejections.

Response to Arguments

Applicant's arguments filed on March 24, 2009 have been fully considered but they are not persuasive.

Applicant asserts Drechsler excludes the presently claimed wetting agent by requiring that "the overcoat does not significantly disrupt the composition of the present invention". However, the wetting activity of polyalpha olefin is not viewed as a *disruption* of the film-formed on the substrate, and there is nothing in the record to suggest that this emollient/wetting agent is a reactive with the film-forming composition of Drechsler.

Applicant's remarks with respect to the comparison tests of the affidavit concurrently filed with the amendment have been addressed above, under Oath/Declaration.

Conclusion

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to GINA C. YU whose telephone number is (571)272-8605.

The examiner can normally be reached on Monday through Friday, from 9:00AM until 5:30 PM..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sharmila Landau can be reached on 571-272-0614. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Gina C. Yu/
Primary Examiner, Art Unit 1611